

REMARKS

I. STATUS OF CLAIMS AND ELECTION

Claims 1-31 were presented for examination. Applicant hereby elects for examination Claims 1-12, 13, 15-24, 26-28, and 30-31, which are readable on Invention I and alleged Species IA, with traverse. Claim 13 is amended herein. Claim 14 is withdrawn pending reconsideration. Claims 25 and 29 are withdrawn. Thus, claims 1-12, 13, 15-24, 26-28, and 30-31 have been elected for examination and are pending.

II. TRAVERSAL OF RESTRICTION REQUIREMENT

Restriction to alleged Inventions I, II, and III was required. Applicant has elected Invention I and does not traverse or contest the restriction as between alleged inventions I, II, and III. The Office Action also requires election among alleged group IA and group IB, which Applicant traverses.

The patent statute, rules and Office practice permit the Office to restrict claims only in limited circumstances when multiple inventions are presented. The MPEP states that “[t]here are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent ...; **and (B) There must be a serious burden on the examiner if restriction is required**” (§ 803, under the heading “CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS”) (emphasis added). Furthermore, “[f]or the purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02” (*Id.*, under the heading “GUIDELINES”) (emphasis added).

In setting out the restriction requirement concerning the alleged species IA and IB, the Office Action merely states “upon further consideration, it appears claims 13 and 14 of Group I

are different species” (page 6, paragraph 6h). There is no showing of burden, different classification, or any other reason why the Office cannot efficiently examine claims 13 and 14 in the same case. Given the number of other claims that are already grouped in invention I, no serious burden can arise by examining one additional claim. Further, the Office now uses sophisticated computer-based search tools that enable the Office to search the subject matter of both claims 13 and 14 easily using keywords or technical classifications relating to electronic gift certificate processing. The fact that claims 13 and 14 recite different locations for certificate redemption does not create an issue of serious burden.

The only basis in the Office Action for restricting claims 13 and 14 is that the subject matter is allegedly mutually exclusive. The restriction is improper for two reasons. First, only MPEP 806.04(f) provides for restriction among allegedly mutually exclusive species claims, and that section alone is an exceptionally weak legal basis upon which to rely. The USPTO has never adopted the MPEP by administrative rulemaking, and the provisions of MPEP 806.04(f) are not found in any rule of Title 37, Code of Federal Regulations or any patent law statute in Title 35, United States Code. The law and rules **expressly allow multiple species** in an application when a generic claim is present: “Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form ...” 37 C.F.R. §1.141. Applicant has played by the rules exactly, presenting dependent claims to a reasonable number of species, and the Office admits in the Office Action that claim 1 is generic.

Second, even if MPEP 806.04(f) is correct, the claims are not in fact mutually exclusive.

In the approach of the claims, an electronic certificate could be redeemed **in part via a call center and in part at a retail store**. Nothing in the claims says that the **entire** certificate value must be redeemed only in one location, and the Office Action cites nothing from the specification to infer such a limitation. Therefore, the species restriction is unsupported in fact.

As amended, claim 13 is generic with respect to the subject matter of former claims 13 and 14, and clarifies that information for certificate redemption may be received via a physical means that may be a call center or a retail store. However, upon withdrawal of the restriction requirement among IA and IB in response to Applicant's traversal, Applicant will amend claim 13 to present claim 13 in original form.

The Office Action has failed to establish a *prima facie* showing that a serious burden exists on the examiner in examining Claims 13 and 14 in the present application as required by MPEP § 803. Although the MPEP provides that piecemeal prosecution is to be avoided, the Applicant has now had to address one telephone restriction requirement and a written restriction requirement, but no substantive action in the case has occurred. Continued procedural maneuvering does not promote administrative efficiency and is not in the Office's interest when a single claim is involved and no serious burden exists.

Reconsideration and withdrawal of the restriction requirement relating to alleged species IA and IB are respectfully requested.

III. CONCLUSIONS & MISCELLANEOUS


For the reasons set forth above, all of the pending claims are now in condition for allowance. The Examiner is respectfully requested to contact the undersigned by telephone relating to any issue that would advance examination of the present application.

A petition for extension of time, to the extent necessary to make this reply timely filed, is hereby made. If applicable, a law firm check for the petition for extension of time fee is enclosed herewith. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on Nov. 10, 2006 by Martina Placid
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